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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,269

01/30/2006

Tomoaki Hoshino

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7590

01/18/2007

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EXAMINER

WOODWARD, CHERIE MICHELLE

ART UNIT

PAPER NUMBER

1647

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,269	<b>Applicant(s)</b> HOSHINO, TOMOAKI	
	<b>Examiner</b> Cherie M. Woodward	<b>Art Unit</b> 1647	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 2-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/30/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/27/2006</u>   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's election with traverse of Group I (claim 1) in the reply filed on 13 October 2006 is acknowledged. The traversal is on the grounds that the Torigoe et al., references do not disclose a soluble human IL-18R $\alpha$  in the naturally cleaved soluble form. Applicant argues that the Torigoe et al., references instead discloses an artificial construct that is extracted from the cell membrane using CHAPS, which results in an artificial construct. This is not found persuasive because both Torigoe et al., references describe the soluble human IL-18R $\alpha$ . Although Applicant's have amended claim 1 to recite a "natural" soluble human IL-18R $\alpha$ , an unisolated, natural protein is a product of nature and as such, is unpatentable under 35 USC 101. Applicant's amended claim 1 also recites that the "natural" soluble human IL-18R $\alpha$  be in a purified and/or isolated and/or synthesized form. As such, Applicant's claim still reads on the recombinant soluble IL-18R $\alpha$  described by the Torigoe et al., references.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 30 January 2006 has been considered to the extent possible. A signed copy is attached hereto. The English abstracts of the JP 11-100400 and WO 0180891 have been considered. However, the documents themselves have not been considered because they are not in the English language. They will be considered if and when translations are submitted.

### ***Specification***

3. The use of the trademarks PHARMACIA (p. 14) and NUNC (p. 12) have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Torigoe et al., J Biol Chem. 1997 Oct 10; 272(41):25737-42 or Torigoe et al., US Patent 6,087,116 (11 July 2000, priority to 12 March 1997).

The claim recites a natural soluble human IL-18R $\alpha$  in a purified and/or isolated and/or synthesized form. Torigoe et al, teach soluble IL-18R $\alpha$ , which is also called IL-1R $\rho$  in recombinant form (see specifically the JBC reference, p. 25737, abstract; and the entire document; see also, the '166 patent, Example 6, column 16, lines 60-67 to column 18, lines 1-28 and claims 1-6). The '161 patent also teaches IL-18R  $\alpha$  as being obtainable through gene expression (column 3, lines 23-31). As such, claim 1 is clearly anticipated by Torigoe et al., or the '181 patent.

### *Conclusion*

NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cherie M. Woodward whose telephone number is (571) 272-3329. The examiner can normally be reached on Monday - Thursday 9:00am-7:30pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CMW

AU 1647

  
JANET L. ANDRES  
SUPERVISORY PATENT EXAMINER